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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,272	11/30/2000	Rabindranath Dutta	AUS9-2000-0650-US1	5240

7590 08/12/2003
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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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362I

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/726,272

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-18,20-30 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-18,20-30 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-6, 8-18, 20-30 and 32-36 have been examined.

Response to Amendment

2. Applicant's arguments with respect to claims 1-6, 8-18, 20-30 and 32-36 have been considered but are moot in view of the new ground(s) of rejection. The Applicant's amendment has affected the Examiner's technological assessment of the Applicants claims. Specifically, the new limitations added (i.e. "storing the received digital works on a non-volatile storage device accessible from the third party logging server..." and "transmitting the requested digital work from the third party logging server to the merchant computer...") and its interrelationship with the existing dependent claims casts the claimed invention in a different light.

Claim Objections

3. Claims 8, 20 and 32 are objected to because of the following informalities: They depend from canceled claims 7, 19 and 31, respectively. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6, 8-18, 20-30 and 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 13 and 25, the Applicant recites storing digital works on a non-volatile storage. However, the digital work is transferred to the merchant by the third party logging server. It is not clear how this is possible as, according to the claims, the third party logging server never accesses the digital work stored by the non-volatile storage device, and therefore, cannot provide the digital work to the merchant.

Claims 2-6, 8-12, 14-18, 20-30 and 32-36 are also rejected as they depend from claims 1, 13 and 15 respectively.

Claim 25 recites the limitation "the non-volatile storage device" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claims 26-36 are also rejected as they depend from claim 25.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 9, 10, 13, 21, 22, 25, 33 and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beattie et al., U.S. Patent No. 5,659,742

As per claims 1, 9, 10, 13, 21, 22, 25, 33 and 34, Beattie et al. teach receiving digital works from a provider, assigning product identifiers to the digital works, storing digital works in a non-volatile storage device accessible from a third party logging server, receiving a product sale identifier, corresponding to a digital work from a merchant computer, transmitting the requested work from the third party logging server to the merchant computer and storing a sales record in response to receiving the product sale identifier (abstract; figures 1-3, 4A, and 5A; column/line 12/65-13/28; column/line 19/65-20/22; column/line 26/26-23; column/line 35/57-36/13). Beattie et al. also teach registering merchants and

providers with a third party and allowing access to the system post-registration (figures 4-5; column/line 3/25-4/7; column/line 4/22-5/33).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-6, 8, 14-18, 20, 26-30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beattie et al., U.S. Patent No. 5,659,742 in view of Rosenberg et al., U.S. Patent No. 6,363,357.

As per claims 2-6, 8, 14-18, 20, 26-30, and 32, Beattie et al. also teach receiving a royalty rate corresponding to the product identifier, and modifying and calculating an account balance for a provider (column/line 35/29-36/60; column 37, lines 15-39). However, Beattie et al do not specifically recite calculating an account balance for a merchant. Rosenberg et al. teach a system for obtaining digital content that comprises compensating content owners for the use of their works (figure 6). Specifically, Rosenberg et al. teach calculating an account balance for the merchant, receiving payment from the merchant in response to

receiving a product sale identifier, transferring funds between a merchant account and provider account (figures 6 and 8). Rosenberg et al. also teach receiving a royalty rate from a provider and providing it to a merchant (figures 1, 2 and 5). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Beattie et al. and Rosenberg et al. in order to determine whether a user has sufficient funds available in order to access a desired digital work ('742, column 35, lines 58-67; '357, figure 6).

10. Claims 11, 12, 23, 24, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beattie et al., U.S. Patent No. 5,659,742.

As per claims 11, 12, 23, 24, 35 and 36, Beattie et al. teach a general search engine that receives inquiries, searches a data store, prepares a search result in response to searching and returns a result (figures 1-4A). The type of data sought and the name of the party or parties who perform the inquiry is merely descriptive, hence it would have been obvious to one of ordinary skill allow a user to query a database or databases to obtain whatever data he or she desires.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- CMU Software Engineering Institute defines Three-Tier Architecture
 - Logue et al teach a proxy server for retrieving data

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

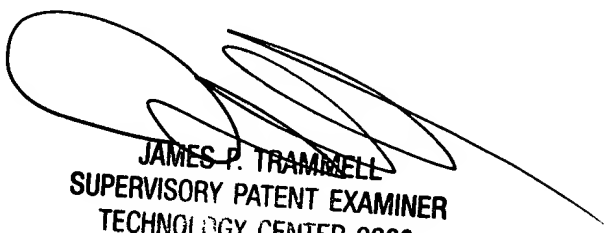
(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

July 30, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600